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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)
YOR920030423US1

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on _____

Signature _____

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Application Number	Filed
10/718,210	2003-11-20

First Named Inventor
Parijat Dube et al.

Art Unit	Examiner
3624	Brandi P. Parker

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

- ☐ applicant/inventor.
- ☐ assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)
- ☑ attorney or agent of record. Registration number 59,329
- ☐ attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____

Signature

David E. Shifren
Typed or printed name

516-759-2641
Telephone number

October 26, 2010
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patent Application

Applicant(s):	P. Dube et al.
Docket No.:	YOR920030423US1
Serial No.:	10/718,210
Filing Date:	November 20, 2003
Group:	3624
Examiner:	Brandi P. Parker
Title:	Methods and Apparatus for Managing Computing Resources Based on Yield Management Framework

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REMARKS FOR PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants respectfully request review of the final Office Action dated May 26, 2010, in the above-identified application. No amendments are being filed with this request. A Notice of Appeal is submitted concurrently herewith. Applicants incorporate by reference herein all previous responses filed in the above-identified application.

REMARKS

The present application was filed on November 20, 2003 with claims 1-19. Claims 11 and 19 have been previously canceled. Claims 1-10 and 12-18 remain pending, including independent claims 1, 17 and 18.

Claims 1-3, 5-10, 12 and 15-18 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,526,392 (hereinafter "Dietrich") in view of U.S. Patent Application Publication No. 2003/0088457 (hereinafter "Keil").

Claims 4, 13 and 14 are rejected under 35 U.S.C. §103(a) as being unpatentable over references including Dietrich and Keil.

Claim 1 includes a limitation directed to controlling a usage load level of the one or more computing resources by modulating quantities of products offered to the one or more users of the one or more computing resources. Claim 1 specifies that these products comprise combinations of price levels and service levels and that the combinations are determined by (i) computing a set of prices and (ii) computing a set of service levels to offer to the one or more users at each one of the prices in the set of prices.

In order to compute a set of service levels to offer at each one of the prices in the set of prices, it is required that the set of prices already exist (i.e., already be computed). In other words, claim 1 requires that the set of prices be computed before the set of service levels to offer at each of the prices in the set of prices. As described in the specification at, for example, page 7, lines 1-17, this is an important distinction from the yield management techniques disclosed by the prior art, and illustrative embodiments are able to better account for the heterogeneous nature of computing resources.

Applicants respectfully submit that neither Dietrich nor Keil teach or suggest an arrangement which includes products of the type recited in claim 1, much less modulating quantities of such products. Dietrich discloses a technique which first determines "a profile of the services to be contracted to one or more new customers," and then determines "a range of prices to be considered for the services to be contracted." See Dietrich at, for example, column 1, line 56, to column 2, line 27. Similarly, Keil at paragraph [0010] discloses a system in which allows a "manufacturer to

choose product configurations, as well as production amounts and prices for each product configuration."

Note that in both Dietrich and Keil, the services/product configurations are determined first, and then prices for those services/product configurations are determined. Accordingly, not only do Dietrich and Keil fail to teach or suggest the limitations of claim 1, but both references teach directly away therefrom.

In the Advisory Action dated September 27, 2010, the Examiner argues that "[t]he claim language fails to provide an order for the steps necessary to determine the price and service combinations" and that the "specification fail[s] to specify that a set of prices is required to be computed before the set of service levels."

Applicants respectfully submit that the Federal Circuit has enunciated "a two-part test for determining if the steps of a method claim that do not otherwise recite an order, must nonetheless be performed in the order in which they are written. First, we look to the claim language to determine if, as a matter of logic or grammar, they must be performed in the order written. . . . If not, we next look to the rest of the specification. . . ." *Altiris Inc. v. Symantec Corp.*, 318 F.3d 1363, 1371, 65 USPQ2d 1865, 1869 (Fed. Cir. 2003), citing *Interactive Gift Express, Inc. v. CompuServe Inc.*, 256 F.3d 1323, 1343, 59 USPQ2d 1401, 1416 (Fed. Cir. 2000).

In the present case, Applicants respectfully submit that the claim language is such that claim 1 logically requires that the set of prices be computed before the set of service levels to offer at each of the prices in the set of prices. Logically, in order to compute a set of service levels to offer at each one of the prices in the set of prices, it is required that the set of prices already exist (i.e., already be computed). Thus, Applicants respectfully disagree with the Examiner's contention that "[t]he claim language fails to provide an order for the steps necessary to determine the price and service combinations"

See, e.g., *Loral Fairchild Corp. v. Sony Electronics Corp.*, 181 F.3d 1313, 1321, 50 USPQ2d 1865, 1870 (Fed. Cir. 1999) (holding that the claim language itself indicated that the steps had to be performed in their written order because the second step required the alignment of a second structure with a first structure formed by the prior step); *Mantech Envtl. Corp. v. Hudson Envtl. Servs., Inc.*, 152 F.3d 1368, 1375-76, 47 USPQ2d 1732, 1739 (Fed. Cir. 1998) (holding that the steps of a method

claim had to be performed in their written order because each subsequent step referenced something logically indicating the prior step had been performed).

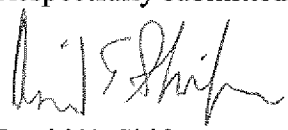
Moreover, because claim 1 itself indicates that the set of prices be computed before the set of service levels to offer at each of the prices in the set of prices, it is irrelevant whether the "specification fail[s] to specify that a set of prices is required to be computed before the set of service levels," as alleged by the Examiner in the Advisory Action. As noted above, the Federal Circuit has indicated that the specification is only considered when the claim language itself does not require, as a matter of logic and grammar, that the steps at issue be performed in a specified order.

In view of the foregoing, claim 1 is patentable over the cited references. Independent claims 17 and 18 include limitations similar to those heretofore discussed with reference to claim 1, and are thus similarly patentable.

Applicants also assert that dependent claims 2-10 and 12-16 are patentable over the reference not only for the reasons given above, but also because one or more of said dependent claims recite separately patentable subject matter in their own right. Moreover, the other references cited by the Examiner in rejecting certain of the dependent claims fail to remedy the above-identified deficiencies of Dietrich and Keil relative to the limitations of claim 1.

In view of the above, Applicants believe that the present application is in condition for allowance, and respectfully request withdrawal of the §103(a) rejections.

Respectfully submitted,



Date: October 26, 2010

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